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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

09/752,926

01/02/2001

Veronique Mary

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01/08/2004

EXAMINER

MAIER, LEIGH C

ROSS J. OEHLER
AVENTIS PHARMACEUTICALS INC.
ROUTE 202-206
MAIL CODE: D303A
BRIDGEWATER, NJ 08807

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12302003

Application Number: 09/752,926
Filing Date: January 02, 2001
Appellant(s): MARY ET AL.

Irving Newman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 3, 2003.

(1) *Real Party in Interest*

The brief does not contain a statement identifying the Real Party in Interest. Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

(2) *Related Appeals and Interferences*

The brief states that there are no other related appeals and interferences, known to Appellant, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

There is only one claim on appeal.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

However, it is noted that the claim contains an obvious typographical error: "patent" should be "patient." This error is in the original.

(9) *Prior Art of Record*

Pratt, J. et al., "Enoxaparin Reduces Cerebral Edema after Photothrombotic Injury in the Rat" Haemostasis, vol. 28, (1998), pp. 78-85.

(10) *Grounds of Rejection*

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by PRATT et al (Haemostasis, 1998).

PRATT discloses the administration of a pharmaceutical composition comprising enoxaparin to a subject with cerebral ischemia. The disclosed treatment comprises administration enoxaparin at a dosage protocol of 0.5 mg/kg i.v. followed 15 min. later by 2 mg/kg s.c. starting either 2, 6, or 18 hr after lesion formation. See abstract and page 80, right-hand column. In the specification, "effective amount" is defined as 0.2 mg/kg to 4 mg kg per day s.c. See specification at page 7, second full paragraph.

(11) *Response to Argument*

Appellant states that the instant invention relates to "the use of enoxaparin to treat – and reduce the size of – ischemic lesions of cerebral ischemia" whereas PRATT is concerned with the treatment of edema that is induced by ischemia, which is in turn induced by photothrombotic lesion. Appellant further contends that PRATT is silent regarding the size of the ischemia itself.

The examiner first notes that the claim is drawn to a "method of treating cerebral ischemia," and the step of the method is "administering to a [patient] in need thereof an effective amount of enoxaparin. The claim recites *treating* but does not require reduction in size.

Silence regarding the size of the ischemia notwithstanding, PRATT does, in fact, disclose administration of an effective amount of enoxaparin to a subject with cerebral ischemia. The reference discloses performing the recited step on the required subject, thereby accomplishing the method.

Appellant goes on to discuss the photothrombotic model used by PRATT and the perceived deficiencies thereof. It appears that Appellant's argument is that this model is not the preferred one for the study of cerebral ischemia and (1) that "it is unlikely that enoxaparin was able to affect lesion volume" in this model; and (2) it would prevent the detection of benefits. That may be, but it is not on point. The claim requires neither reduction in lesion volume nor detection of said reduction.

Finally, Appellant states "Examiner's argument that use of enoxaparin for reducing the size [of] the lesion was inherently practiced in the prior art is untenable and unsupported by any basis in fact." The examiner respectfully submits that it has never been argued that the art discloses reduction in lesion size but maintains that the art does disclose the method, as recited.

Appellant's position is that the cited reference does not describe or suggest the use of enoxaparin in the treatment of cerebral ischemia. This argument contradicts what is clearly stated in the reference, as set forth above. For the above reasons, it is believed that the rejections should be sustained.

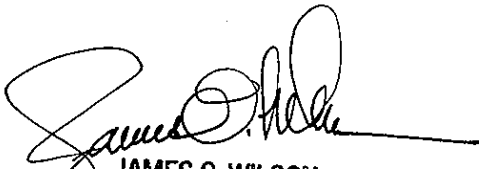
Application/Control Number: 09/752,926
Art Unit: 1623


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Respectfully submitted,

CONFEREES


SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1600


JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600


JONANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1600

December 30, 2003